UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,327	12/05/2003	Penny L. Gerstner	014033.000018	1326

69603   7590   05/27/2009
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EXAMINER
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ART UNIT	PAPER NUMBER
3691	

MAIL DATE	DELIVERY MODE
05/27/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 March 2009</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-35</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-35</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   The communication is in response to Applicant's amendment filed on March 3rd,

2009. The Amendment/Remarks received on February 3rd, 2009, have been entered.

Claims 1-35 are pending. The rejections are as stated below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to not-statutory subject matter.

Claims 1-11 recite a method of processing account-holder requests to authorize

recurring third-party transactions for an account at a financial institution on behalf of an

account holder, comprising method steps such as receiving, matching, forwarding,

receiving and forwarding. Based on Supreme Court precedent, a proper process must

be tied to another statutory class or transform underlying subject matter to a different

state or thing *(In Re Bilski; Diamond v. Diehr,* 450 U.S. 175, 184 (1981); *Parker v.*

Flook, 437 U.S. 584,588 n.9 (1978); *Gottschalk v. Benson,* 409 U.S. *63,* 70 (1972);

Cochrane v. Deener, 94 U.S. 780,787-88 (1876)). Since neither of these requirements

is met by the claim, the method is not considered a patent eligible process under 35

U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other

statutory class to which it is tied, for example by identifying the apparatus that

accomplished the method steps or positively reciting the subject matter that is being

transformed, for example by identifying the material that is being changed to a different

state. Since the steps can be accomplished without the use of another statutory class, it

is considered a non-statutory process.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

3.   Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by

Neofytides et al. (U.S. 7,376,587).

As per claim 1, Neofytides et al. teaches a method of processing account-holder

requests to authorize recurring third-party transactions for an account at a financial

institution on behalf of the account holder (See col. 1, lines 57, through col. 2, line 2,

and col. 6, line 37, through col. 7, line 23, which discusses hardware and software for

implementing an electronic money transfer, including recurring transactions), the

method comprising:

receiving, at the financial institution, the account-holder request to authorize the third party transactions (See col. 5, line 38, through col. 6, line 9, which discusses how a payor initiates debiting his/her bank account in an electronic monetary transaction);

matching at least one specific request from among the account-holder requests to at least one specific third-party participant (See col. 11, line 62, through col. 12, line 8, which discusses matching requests to transfer money using a security question);

forwarding the at least one specific request to the at least one specific, third-party participant on behalf of the account holder (See col. 11, lines 48-56, which discusses sending a payee an email to confirm payment from a payor);

receiving, at the financial institution, at least one participant confirmation from the at least one specific third-party participant (See col. 11, lines 48, through col. 12, line 8, which discusses how a payee confirms approval of an electronic money transfer), wherein the at least one participant confirmation comprises a confirmation that the at least one specific third-party participant's accounting system has been updated based on the at least one specific request (See col. 13, lines 4-14, and col. 14, lines 20-27, which discusses updating transaction files); and

forwarding, from the financial institution, an account-holder confirmation of the at least one participant confirmation of the at least one specific request to the account holder (See col. 12, lines 34-46, which discusses how a payor confirms the transaction).

As per claim 2, Neofytides et al. teaches establishing a pre-existing list of prospective third-party participants, wherein the at least one specific third-party

participant is selected from the pre-existing list (See col. 9, line 52, through col. 10, line 49, which discusses an address book that functions as a source of prospective payees).

As per claim 3, Neofytides et al. teaches wherein at least one of the forwarding of the at least one specific request to the at least one specific, third-party participant and the receiving, at the financial institution, the at least one participant confirmation from the at least one specific third-party participant is accomplished in accordance with participant communication preferences stored in a participant profile for the at least one specific third-party participant, the participant profile being stored in a data repository comprising participant profiles associated with the prospective third-party participants (See col. 10, line 49, through col. 11, line 19, which discusses registering an individual or payee's profile, storing the profile, and confirming the profile according to a preferred method).

As per claim 4, Neofytides et al. teaches wherein the forwarding, from the financial institution, of the account-holder confirmation of the at least one participant confirmation of the at least one specific request to the account holder is accomplished in accordance with account-holder communication preferences stored in an account-holder profile (See col. 8, lines 26-54, which discusses a user or payor profile and how a user or payor may confirm a money receipt method).

Claim 5 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

As per claim 6, Neofytides et al. teaches wherein the account-holder requests comprise at least one direct-deposit request to authorize the at least one specific third-party participant to periodically direct deposit funds to the account (See col. 1, lines 57, through col. 2, line 2, and col. 4, lines 1-10, which discusses how a user directs recurring money transfer requests to another individual or entity).

Claims 7-10 recite equivalent limitations to claim 6 and are therefore rejected using the same art and rationale set forth above.

As per claim 11, Neofytides et al. teaches a computer program product comprising a computer-readable storage medium having a computer program embodied therein for enabling a financial institution to authorize recurring third-party transactions for an account on behalf of an account holder (See col. 1, lines 57, through col. 2, line 2, and col. 6, line 37, through col. 7, line 23, which discusses hardware and software for implementing an electronic money transfer, including recurring transactions), the computer program further comprising:

instructions for receiving account-holder requests, wherein specific requests from among the account-holder requests authorizes specific third party participants to perform a plurality of the recurring third-party transactions on behalf of the account

holder (See col. 1, lines 57, through col. 2, and col. 5, line 38, through col. 6, line 9,

which discusses recurring transactions; and, furthermore, how a payor initiates debiting

his/her bank account in an electronic monetary transaction);

instructions for matching the specific requests from among the account-holder

requests to the specific third-party participants (See col. 11, line 62, through col. 12, line

8, which discusses matching requests to transfer money using a security question);

instructions for forwarding the specific requests to the specific third-party

participants on behalf of the account holder (See col. 11, lines 48-56, which discusses

sending a payee an email to confirm payment from a payor);

instructions for receiving participant confirmations from the specific third-party

participants (See col. 11, lines 48, through col. 12, line 8, which discusses how a payee

confirms approval of an electronic money transfer); and

instructions for forwarding an account-holder confirmation of the participant

confirmations of the specific requests to the account holder (See col. 12, lines 34-46,

which discusses how a payor confirms the transaction).

Claims 12-14 recite equivalent limitations to claims 2-4, respectively, and are

therefore rejected using the same art and rationale set forth above.

Claim 15 recites equivalent limitations to claim 4 and is therefore rejected using

the same art and rationale set forth above.

Claim 16-20 recites equivalent limitations to claim 6 and are therefore rejected

using the same art and rationale set forth above.

As per claim 21, Neofytides et al. teaches an apparatus to enable a financial

institution to authorize recurring third-party transactions for an account on behalf of an

account holder (See col. 1, lines 57, through col. 2, line 2, and col. 6, line 37, through

col. 7, line 23, which discusses hardware and software for implementing an electronic

money transfer, including recurring transactions), the apparatus comprising:

means for receiving account-holder requests wherein specific requests from

among the account-holder requests authorizes specific third party participants to

perform a plurality of the recurring third-party transactions on behalf of the account

holder (See col. 1, lines 57, through col. 2, and col. 5, line 38, through col. 6, line 9,

which discusses recurring transactions; and, furthermore, how a payor initiates debiting

his/her bank account in an electronic monetary transaction);

means for matching the specific requests from among the account-holder

requests to the specific third-party participants (See col. 11, line 62, through col. 12, line

8, which discusses matching requests to transfer money using a security question);

means for forwarding the specific requests to the specific third-party participants

on behalf of the account holder (See col. 11, lines 48-56, which discusses sending a

payee an email to confirm payment from a payor);

means for receiving participant confirmations from the specific third-party participants (See col. 11, lines 48, through col. 12, line 8, which discusses how a payee confirms approval of an electronic money transfer); and

means for forwarding an account-holder confirmation of the participant confirmations of the specific requests to the account holder (See col. 12, lines 34-46, which discusses how a payor confirms the transaction).

Claims 22-24 recite equivalent limitations to claims 2-4, respectively, and are therefore rejected using the same art and rationale set forth above.

Claim 25 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

As per claim 26, Neofytides et al. teaches a computer-readable storage medium comprising a system to enable a financial institution to authorize recurring third-party transactions for an account on behalf of an account holder (See col. 1, lines 57, through col. 2, line 2, and col. 6, line 37, through col. 7, line 23, which discusses hardware and software for implementing an electronic money transfer, including recurring transactions), the system comprising:

a user interface to receive account-holder requests, wherein specific requests from among the account-holder requests authorizes specific third party participants to perform a plurality of the recurring third-party transactions on behalf of the account

holder (See figure 1, col. 1, lines 57, through col. 2, and col. 5, line 38, through col. 6,

line 9, which illustrates and discusses a user or payer computer, recurring transactions,

and how a payor initiates debiting his/her bank account in an electronic monetary

transaction);

at least one engine operatively connected to the user interface, the at least one

engine to match the specific requests from among the account-holder requests to the

specific third-party participant (See figure 1, and col. 5, line 38, through col. 6, line 9,

which illustrates and discusses a payment enabler or intermediary, and how a payor

initiates debiting his/her bank account in an electronic monetary transaction);

a third-party participant interface to forward the specific requests to the specific

third-party participants, the third-party participant interface operatively connected to the

at least one engine (See figure 1, and col. 11, line 62, through col. 12, line 8, which

illustrates and discusses and payee or third party computer, and matching requests to

transfer money using a security question)and ;

a least one data repository operatively connected to the at least one engine, the

at least one data repository further comprising third-party participant profiles (See col.

10, line 49, through col. 11, line 19, which discusses registering an individual or payee's

profile, storing the profile, and confirming the profile according to a preferred method);

and

a fulfillment system to provide account-holder confirmation of the specific

requests, the fulfillment system operatively connected to the at least one engine (See

col. 12, lines 34-46, which discusses how a payor confirms the transaction).

Claim 27 recites equivalent limitations to claim 2 and is therefore rejected using the same art and rationale set forth above.

Claim 28 recites equivalent limitations to claim 6 and is therefore rejected using the same art and rationale set forth above.

Claim 29 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

As per claim 30, Neofytides et al. teaches wherein the account-holder communication preferences comprises at least one of electronic and paper communication preferences (See claim 1, which discusses communicating by an email address).

Claim 31 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

Claim 32 recites equivalent limitations to claim 30 and is therefore rejected using the same art and rationale set forth above.

As per claim 33, Neofytides et al. teaches wherein the user interface is operable to receive the account-holder requests from the account-holder over the internet (See figure 1, which illustrates receiving user requests over the internet).

Claims 34 & 35 recite equivalent limitations to claim 33 and are therefore rejected using the same art and rationale set forth above.

Response to Arguments

4.   Applicant's arguments filed on February 3rd, 2009 , with respect to the 35 U.S.C. § 112 2nd and 101 rejections have been fully considered and are persuasive. Therefore, the rejections have been withdrawn.

Applicant's arguments filed on February 3rd, 2009 , with respect to the 35 U.S.C. § 102 rejection, have been fully considered but they are not persuasive.

In response to Applicant's argument against 35 U.S.C. 102(e), the Examiner respectfully disagrees. Based on a broad and reasonable interpretation, the Examiner has identified that the recited elements are disclosed, taught, and suggested in the prior art.

Neofytides clearly teaches reoccurring transactions, specifically contemplates that remote individuals periodically direct a reoccurring payment (See col. 1, line 57,

through col. 2, line 2), and individuals initiate bank account debits in an electronic

monetary transaction (See col. 5, line 38, through col. 6, line 9).

As mentioned in the previous office actions, It is inherent from the disclosure in

Neofytides that a financial institution is utilized to receive authorization requests. The

Examiner refers Applicant to the bank accounts used to complete the payment

transaction (See col. 2 lines 40-47, and col. 5, lines 38-45). A bank account does not

exist without a corresponding bank. Furthermore, banks are not authorized to transfer

funds without the express consent of the corresponding bank account holder. .

Neofytides clearly outlines the steps of confirming a transaction (See col. 9, line 52,

through col. 10, line 49). In conjunction with this disclosure, Neofytides discloses the

step of incorporating authorized third parties (See col 6, lines 23-36).

Conclusion

5.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Hani Kazimi whose telephone number is (571) 272-

6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published

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have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

Customer Service Representative or access to the automated information system, call

800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hani M. Kazimi/

Primary Examiner, Art Unit 3691